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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957

No. 711

PETROCARBON LIMITED, *Petitioner*,

v.

ROBERT C. WATSON, Commissioner of Patents,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

REPLY BRIEF OF PETITIONER

RALPH H. HUDSON
700 Tenth St., N. W.
Washington 1, D. C.

HAROLD J. KINNEY
CRUZAN ALEXANDER
900 Bush Avenue
St. Paul 6, Minnesota

M. K. HOBBS
Platteville, Wisconsin

Attorneys for Petitioner

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REPLY BRIEF OF PETITIONER

The dissent of Judge Burger (Pet. App. 14a-15a) in the Court of Appeals is profoundly correct, particularly in its statements that it is unsound as a matter of *law* to say that the District Court was correct in holding that the application lacked a disclosure of utility, while denying the appellant its right to offer proof to the contrary.

Section 145, Title 35 (Pet. App. 1a) provides for a "Civil Action to Obtain a Patent". A civil action is a trial *de novo*. It involves a hearing and the produc-

tion of evidence. The civil action provided by Section 145 is *not* an *appeal* from the Patent Office to review questions of law. An *appeal* from the Patent Office is taken to the Court of Customs and Patent Appeals (Title 35, Sections 141-144).

Such appeals are heard on a certified record (Sec. 143) and are determined "on the evidence produced before the Patent Office" (Sec. 144).

The question of whether the Court of Appeals was right or wrong in denying the applicant a patent is incidental to this petition. But it is a question of great public moment that that Court and the District Court misconceived the mandate of the Congress to afford the petitioner a hearing in a "civil action", as provided in Section 145.

There was a clear departure from the accepted course of judicial proceedings.* This is epitomized in Judge Burger's terse statement (Pet. App. 14a-15a):

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* The footnote on page 8 of respondent's brief asserts that petitioner was not deprived of its property without due process of law, because petitioner "never secured letters patent". But the footnote ignores the facts that petitioner's patent application has been rejected, and that rights based on its filing date have thus been destroyed. A patent application "is itself property" (Refining, Inc. v. Sharples Specialty Co., 21 F. Supp. 511, 513), and patent applications are expressly made assignable and their assignments recordable by 35 U.S.C. 261. Chemical Foundation v. General Aniline Works, 99 F. 2d 276, cited by respondent, said merely that "so long as the inventor * * *does not seek a patent* * * the *mere conception* of an invention cannot be seized and sold". Respondent's other authority, Mullins Manufacturing Co. v. Booth, 125 F. 2d 660, 664, *rejected* the contention that "Booth had but an application, and so no property right to assign", and held that the contract involved in the case "was founded upon no greater interest in property than is represented by patent applications".

> "The District Court should have permitted appellant an opportunity to make good on this offer of proof (of utility) and then evaluated the testimony before deciding the case."

This statement is particularly significant in view of the observation of the Court of Appeals (Pet. App. 13a) that "In this court the Patent Office in effect concedes that the proffered exhibits and testimony would show that the new polymers do adhere to certain substances and protect them against certain acids and other substances". The significance of this statement is not in its relationship to the ultimate success or failure of the applicant, but rather in its acknowledgement that the proffered evidence was *material* on the question of the sufficiency of the application.

Since the petition was filed in the present case, the same Court of Appeals, by another two-to-one decision, decided another case involving substantially the same questions, *Watson, Commissioner of Patents* v. *Bersworth et al.*, decided January 9, 1958, and to date reported only in the advance sheets of the United States Patent Quarterly for January 20, 1958 (116 USPQ 79). The District Court found as a fact that the disclosure of the specification was sufficient to enable one skilled in the art to make and use the involved invention. The majority of the Court of Appeals did "not question any of the testimony", but disregarded the proven fact on the basis that the question was one solely of law which "we answer in the negative".

Judge Danaher dissented, as did Judge Burger in the present case. Petitioner can do no better than to quote Judge Danaher's comment as follows:—

> "The philosophy permeating the majority opinion basically is one of nullification of the remedy

provided by Congress, a result here reached (1) by according to the Patent Office the equivalent of a conclusive presumption of correctness; and (2) by holding that sufficiency of disclosure raises a question of law. Relegated to zero status is the District Court, with its findings, its conclusions, its memorandum opinion and its judgment. Judge Wilkin heard many witnesses, had the benefit of charts and exhibits, received detailed explanations as to the points in issue and possessed the advantage of colloquy with opposing counsel. The record discloses close and careful attention to the many aspects of the case brought under 35 U.S.C. Sec. 145 which permits a dissatisfied applicant to pursue his remedy in the District Court which may adjudge the applicant entitled to receive a patent *'as the facts in the case may appear.'* (Emphasis supplied.)".

The quotations from 35 U.S.C. 112 on page 5 of respondent's brief are both inaccurate and incomplete. In quoting the statutory language requiring "full, clear, concise and exact terms", respondent omits to quote the important word **"such"** which precedes this language. Thus the brief avoids recognition of the qualifying phrase which basically characterizes the requirements of this section of the statute, namely, that the description and terms shall be "such * * * as to enable any person skilled in the art * * * to make and use the same".

Thus by Section 112, whether the specification was sufficient depends upon its meaning and teaching to "person(s) skilled in the art". Affirming the refusal to hear the pertinent testimony of such persons skilled in the art, the Court of Appeals held the specification "defective as a matter of law"

(Pet. App. 14a). And this it did with the observation of the District Court before it that "The question, it would appear, is a close one" (Pet. App. 10a). It was a *fact* question, and not a *law* question, to which the District Court was referring.

None of the authorities cited by respondent deals with the sufficiency of a description to enable a person skilled in the art to use the invention. The Court, where pertinent, may determine the quantum of actual disclosure of a specification, but that is not a question in this case. Here involved is the separate question of the *sufficiency* of that disclosure to teach persons skilled in the art how to *use* the invention. As to this *sufficiency* of the disclosure, the statute obviously contemplates the supplementation of the disclosure by the knowledge of those skilled in the art. Of necessity this question is one of fact. As Judge Burger held, the District Judge should have received the testimony of those skilled in the art in order to evaluate the knowledge of the art, before deciding the case.

Judge Danaher's dissent in *Watson* v. *Bersworth, supra,* followed Judge Burger but went into the questions involved in considerably greater detail. In particular he pointed out that the majority of the Court, like the respondent's brief in the present case, had failed to give effect to the vital characterizing language of the statute itself. As Judge Danaher said in his dissent, and as petitioner here repeats:—

> "The majority, to avoid the impact of our Esso rule, conclude erroneously I think, that here is presented a question of law arising from 'the

words of a patent or a patent application.' The majority say the specification shall set forth its disclosure in 'full, clear, concise, and exact terms * * *. 35 U.S.C. Sec 112,' and 'This is a question of law * * *.' But the majority fail and decline to give effect to the statute at precisely the point critical in this case, for the statute is satisfied if disclosure is in such terms *'as to enable any person skilled in the art to which it pertains * * * to make and use the same * * *.'* (Emphasis supplied.) Thus, the question was not one of construing the 'words' of the application, but whether the disclosure was sufficient to a 'person skilled in the art.' On that point the evidence of the experts is received by the courts, not as determining the issue, but as affording proof upon which the trier must pass as to what the application discloses to those skilled in the art.

* * * * * * * * *

Thus, the experts, and even those not yet graduated, demonstrated the sufficiency of the disclosure. The only question of law was that involved in the judgment of a trier who, when he understood the specifications, was bound to accept the responsibility for decision as to sufficiency. I suggest he correctly decided upon findings arrived at with complete conviction that continuity of the subject matter defined by the claim was maintained before the Patent Office at all times here material.

I see here, not a matter of construing language, not a question of law, but one of fact as to what was disclosed to those skilled in the art."

There is no opportunity ever to have the questions here presented reviewed in any courts other than in the District of Columbia, as Section 145 limits suits

brought under it to "the United States District Court for the District of Columbia".

The basic issue on this petition is fundamental. Congress provided an independent "civil action" (Section 145). The District Court refused to hear proffered testimony acknowledged to be pertinent and material by respondent (Pet. 13a). The Court of Appeals affirmed. The petitioner was denied its civil rights and due process.

The petition should be allowed.

Respectfully submitted,

RALPH H. HUDSON
700 Tenth St., N. W.
Washington 1, D. C.

HAROLD J. KINNEY
CRUZAN ALEXANDER
900 Bush Avenue
St. Paul 6, Minnesota

M. K. HOBBS
Platteville, Wisconsin

Attorneys for Petitioner

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